

### **REMARKS**

Entry of the Amendment, reexamination, and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. §§ 1.114 and 1.111, are thus respectfully requested.

**1. Status of the Claims**

Claims 1-13 stand previously canceled. Claims 14-28 stand pending and rejected.

Upon entry of the present amendments, claims 14 and 22 stand amended to more precisely recite the claimed subject matter. Support for the amendments of claim 14 and 22 can be found at least, for example, from page 6, line 25 to page 10, line 7, and paragraph bridging pages 14-15 of the Specification (Example 3). Applicants do not believe that the amendments add subject matter that is unsupported in the Specification as filed.

The claims have been amended without prejudice to, or disclaimer of, the cancelled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendments.

**2. Acknowledgement of Certified Priority Documents**

Applicants appreciate the Office's acknowledgement of receipt of the certified priority documents.

**3. Acknowledgement of Information Disclosure Statements**

Applicants appreciate the Office's acknowledgement of the Information Disclosure Statement submitted May 26, 2009.

Applicants hereby submit an updated PTO-1449 form with a partial translation of Yoshiyuki et al., JP 11-276074. No fee is believed to be necessary, because a partial translation of Yoshiyuki has been previously submitted. Applicants respectfully request the Office's acknowledgement within the next communication.

**4. Withdrawn Rejections**

Applicants appreciate the Office's withdrawal of the indefiniteness rejection. Stated for the record, Applicants assume that both (1) the prior anticipation rejection of claim 1, and (2) the prior obviousness rejection of claims 1-13 stand mooted and withdrawn, because claims 1-13 were canceled.

**5. Rejection of the Claims Under 35 U.S.C. § 103(a)**

The Office rejects claims 14-28 under 35 U.S.C. § 103(a) as allegedly unpatentable over **Yutaka et al.**, JP 08-116881 ("Yutaka") in view of **Yoshiyuki et al.**, JP 11-276074 ("Yoshiyuki") and **Fu et al.**, U.S. Patent No. 5,827,560 ("Fu").

**5.1. Claims 14-21**

**5.1.1. Claims 14-15 and 18**

Yutaka allegedly discloses a method for producing a tea beverage comprising:

- 1) pulverizing tea leaves to obtain ground tea particles with a size of 125  $\mu\text{m}$  or less;
- 2) suspending the ground tea in water at a density of 5%;
- 3) homogenizing the ground to obtain an ultrafine powder tea; and
- 4) including the ultrafine powder tea as a component in a tea drink.

Office Action, page 3. The Office admits that Yutaka as the primary reference does not disclose the third and the fourth steps (step **e**) and **d**) respectively) recited in claim 14. Step (c) recites removing not less than about 50% of the particles of about 1  $\mu\text{m}$  or more in diameter from the powdered tea to obtain a ground tea dispersion ("the removing step"), and step (d) recites blending the ground tea dispersion with a tea extract to produce said tea beverage. *Id.*, at 3-4.

The Office then applies Yoshiyuki as a secondary reference to cure the defects of Yutaka, e.g., failure to disclose at least step **e**) of claim 14. Yoshiyuki allegedly teaches centrifuging a fine powdery tea dispersion to remove larger particles and leave particles of 1  $\mu\text{m}$  or less in diameter. *Id.*, at 2.

The Office then applies Fu as another secondary reference to cure Yutaka's defect of failing to disclose step (d) of claim 14. Fu allegedly teaches a diluted tea beverage made from a tea extract containing soluble tannins and has a good color. *Id.*, at 4.

Applicants traverse the rejection to the extent it may be applied to the amended claims.

A finding of obviousness under 35 U.S.C. § 103 requires that both the suggestion of the claimed invention and the expectation of success must be in the prior art, not in the disclosure of the claimed invention. *In re Dow Chem. Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). Additionally, "obviousness requires a suggestion of *all* limitations in a claim." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974) (emphasis added). Furthermore, one common inquiry in the above tests of obviousness is whether a skilled artisan would have had reasonable expectation of success to practice the claimed invention. *Examination Guidelines for Determining Obviousness under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,528.

A *prima facie* case of obviousness is not adduced as to the amended claims, because the cited art fails to teach or suggest all claim elements. The removing step of the amended claim 14 recites "removing not less than about 50% of the particles of about 1  $\mu$ m or more from the powdered tea in diameter to obtain a ground tea dispersion ***without adding an antioxidant prior to removing the particles.***" As admitted by the Office, Yutaka fails to teach a removing step at all. Office Action, pages 3-4. The secondary reference Yoshiyuki also fails to teach the claimed removing step. Additionally, Yoshiyuki's method requires an essential step of ***adding antioxidant prior to removing large particles*** of powdery tea to obtain a tea beverage that is free from non-uniform turbidity or precipitation. *See e.g.*, claim 1, ¶¶ [0005], [0021], and [0033] of Yoshiyuki (partial English translation). Applicants do not teach the addition of an antioxidant prior to removing the large particles. Thus, the removing step of Yoshiyuki is further distinguished from the amended claims.

Fu also fails to teach a removing step. Thus, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach all elements of amended claim 14. Without all claim elements taught, there can be no reasonable expectation of success in practicing the claimed methods.

In view of above arguments, claim 14 as amended is non-obvious. Dependent claims 15 and 18 are likewise non-obvious for at least the same reasons. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claims.

5.1.2. Claim 16

The Office admits that the cited references fail to teach the homogenization pressure range recited in claim 16. Office Action, page 4. The Office, however, asserts that a skilled artisan would have optimized the homogenization pressure through routine experimentation to achieve desired efficiency. *Id.*, at 4-5.

Applicants traverse. As discussed in Section 5.1.1 *supra*, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach at least the removing step recited in amended claim 14. As claim 16 depends indirectly from claim 14, claim 16 is non-obvious over cited references for at least the same reasons as claim 14. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claim.

5.1.3. Claim 17

The Office alleges that Yutaka discloses that the ground tea is suspended in water at a density of 5%, *i.e.*, 20 parts by weight of water added to 1 part by weight of ground tea. Office Action, page 5.

Applicants traverse. As discussed in Section 5.1.1 *supra*, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach at least the removing step of amended claim 14. As claim 17 depends directly from claim 14, claim 17 is non-obvious over cited references for at least the same reasons as argued for claim 14. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claim.

5.1.4. Claim 19

Although the Office admits that cited references do not explicitly disclose the recited blending ratio, the Office asserts that a skilled artisan would have selected a 1:1 ratio through common sense. Office Action, page 5.

Applicants traverse. As discussed in Section 5.1.1 *supra*, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach at least the removing step of amended claim 14. As claim 19 depends indirectly from claim 14, claim 19 is non-obvious over cited references for at least the same reasons as claim 14. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claim.

#### 5.1.5. Claims 20-21

The Office alleges that Yutaka discloses all claim limitations as set forth in claim 20. Office Action, page 6. The Office further alleges that Yutaka's beverage would intrinsically display the turbidity recited in claim 21. *Id.*

As argued above, Yutaka fails to teach all the steps of the method for producing the tea product. Accordingly Yutaka's beverage cannot be asserted to have the turbidity or any other property of the presently claimed tea. As discussed in Section 5.1.1 *supra*, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach at least the removing step of amended claim 14. As claims 20-21 as amended depend directly / indirectly from claim 14, claims 20-21 are non-obvious over cited references. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claims.

#### 5.2. Claims 22-28

##### 5.2.1. Claims 22-23 and 25-26

Yutaka's allegedly teaching is as discussed in Section 5.1.1 *supra*. The Office admits that Yutaka as the primary reference does not disclose steps (b) and (c) as recited in claim 22. Office Action, pages 6-7. In the obviousness rejection, the Office apparently applies Yoshiyuki as a secondary reference to cure Yutaka's defect of failing to disclose step (c). Yoshiyuki allegedly teaches centrifuging a fine powdery tea dispersion to remove larger particles and leave particles of 1  $\mu\text{m}$  or less in diameter. *Id.*, at 6. The Office then applies Fu to cure the defect that Yutaka fails to disclose the second step (step b)) of claim 22. Fu allegedly teaches a diluted tea beverage made from a tea extract containing soluble tannins and has a good color. *Id.*, at 7.

Applicants traverse the rejection to the extent it may be applied to the amended claims. The Office cannot adduce *prima facie* obviousness as to the amended claims, because the cited

art fails to teach or suggest all claim elements. First, at least the tea-extract adding / grinding step of claim 22 is *not* taught. Claim 22 as amended recites, *inter alia*, adding a tea extract to the powdered tea and further grinding the powdered tea. Yutaka may teach that powdered tea leaves are suspended in *water* or water containing crystalline cellulose and treated with a NANOMIZER to obtain fine ground tea suspension. See ¶¶ [0019], [0030], and [0032] of Yutaka (partial English translation). Therefore, Yutaka teaches a liquid suspension.

Yoshiyuki may teach that pulverized green tea leaf that is subject to wet pulverization by a NANOMIZER. See ¶¶ [0007], [0008], [0017], [0021], [0022], [0027], and [0038] of Yoshiyuki (partial English translation). However, Yoshiyuki fails to mention the liquid material used in the wet pulverization. Fu also fails to teach the tea-extract adding / grinding step. At best, Fu may teach a diluted tea beverage made from a tea extract containing soluble tannins. Accordingly, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach or suggest at least the tea-extract adding / grinding step of amended claim 22.

Amended claim 22 also now recites “removing not less than about 50% of the particles of about 1  $\mu\text{m}$  or more from the powdered tea in diameter to obtain a ground tea dispersion *without adding an antioxidant prior to removing the particles.*” As admitted by the Office, the primary reference Yutaka fails to teach a removing step at all. Office Action, pages 6-7. Yoshiyuki also fails to teach the claimed removing step. In fact, Yoshiyuki’s method requires the essential step of *adding antioxidant prior to removing large particles* of powdery tea to obtain a tea beverage that is free from non-uniform turbidity or precipitation. See *e.g.*, claim 1, ¶¶ [0005], [0021], and [0033] of Yoshiyuki (partial translation). The removing step taught in Yoshiyuki thus is further distinguishable from amended claim 22. Fu also fails to teach a removing step. Accordingly, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach or suggest at least the removing step of amended claim 22. Without all claim elements taught, there can be no reasonable expectation of success in practicing the claimed methods.

In view of above arguments, claim 22 as amended is non-obvious. Dependent claims 23 and 25-26 are likewise non-obvious for at least the same reasons. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claims.

5.2.2. Claim 24

The Office admits that the cited references fail to teach the homogenization pressure range recited in claim 24. Office Action, pages 7-8. The Examiner nevertheless asserts that a skilled artisan would have optimized the homogenization pressure through routine experimentation to achieve desired efficiency. *Id.*, at 8.

As discussed in Section 5.2.1 *supra*, Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, fail to teach all elements of amended claim 22. As claim 24 depends indirectly from claim 22, claim 24 is likewise non-obvious for at least the same reasons. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claim.

5.2.3. Claims 27-28

The Office alleges that Yutaka discloses all claim limitations as set forth in claim 20. Office Action, page 8. The Office further alleges that Yutaka's beverage would intrinsically display the turbidity recited in claim 21. *Id.*

Claims 27 and 28 depend directly or indirectly respectively from amended claim 22. As argued above, Yutaka fails to teach all the steps of the method for producing the tea product. Accordingly Yutaka's beverage cannot be asserted to have the turbidity or any other property of the presently claimed tea, because the reference fails to teach all the steps necessary to obtain the product. Yutaka, Yoshiyuki, and Fu, alone or when viewed in combination, also fail at least to teach at least the removing step of amended claim 14. As claims 27-28 depend directly / indirectly from claim 22, claims 27-28 are non-obvious over cited references. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claims.

**CONCLUSION**

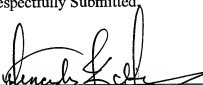
Should the Examiner have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, or for Notice of Appeal, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

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